REMARKS

Claims 1, 8, 11-13, 21, 24, 26, and 45-54 are currently pending in the subject application and are presently under consideration. Claims 1, 11, 12, 13, 45, and 48 have been amended as shown on pp. 2-6 of the Reply. Claims 51-54 are cancelled and claims 55-62 are newly added.

The Examiner is thanked for courtesies extended during an interview conducted on November 25, 2008. The main focus of the interview was on the proposed amended claims against the outstanding rejections. While the presented matter generally related to all the claims, the crux was upon claims 1 and 13. In particular, reference Moran (US 6,509,912) was discussed in the interview. No formal agreement was reached. The interview was conducted with Ronald Krosky (Reg. No. 58,564) and Examiner Rutledge. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection to Claim 51

Claim 51 is objected to because of the following informalities: Line 6 of claim 51 recites "...includes a set of ink stroke that corresponds to the retained electronic ink information." Claim 51 has been cancelled which renders the objection moot; therefore, it is respectfully requested that the objection be removed.

II. Rejection of Claims 51-54 Under 35 U.S.C §112

Claims 51-54 stand rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement. Claims 51-54 has been cancelled which renders the rejection moot; therefore, it is respectfully requested that the rejection be removed.

III. Rejection of Claims 1, 8, 11-13, 21, 24, 26, and 45-50 Under 35 U.S.C. §103(a)

Claims 1, 8, 11-13, 21, 24, 26, and 45-50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moran (US 6,509,912), in view of Saund (US 6,411,732 B1), and further in view of Matthews et al. (US 6,028,604).

> A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007) citing Graham v. John Deere Co. of Kansas City, 383 U. S. 1, 36 (warning against a "temptation to

> read into the prior art the teachings of the invention in issue" and instructing courts to "'guard against slipping into the use of hindsight'" (*quoting Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))).

The claimed subject matter pertains to retention of electronic ink information, such as information gathered from a stylus engaged with a tablet PC. The electronic ink information can be associated with a file and retained in storage. When a file preview occurs, the electronic ink can be disclosed as part of the file preview. Specifically, claim 1 recites in part "the input system is configured to receive in electronic ink format a property value of a document or file as well as a format policy of the property value …the format policy regulates a manner of rendering for the property value…wherein the rendering system renders the stored property value in accordance with the format policy as part of a file preview operation."

In Moran, information can be entered in a handwritten form and associated with a field. The information can be disclosed in the handwritten form along with information that is represented as machine-generated text. Claim 1 recites usage of a format policy that is not taught by Moran. In Moran, information is disclosed as it is entered – specifically, if information is entered as handwritten, then the information is presented as handwritten. Therefore, there is no format policy regulating rendering in Moran as in claim 1, just merely presentation on how information is received. Conversely, claim 1 uses a format policy to determine a manner for rendering electronic ink information.

Claim 45 (dependent off claim 1) states "…further comprising disclosing the file preview in accordance with the format policy." Moran does not teach disclosure with regard to a format policy as recited in claim 45. Disclosure is merely performed with how information is entered and not in accordance with a format policy.

Claim 13 recites in part "…obtaining a request to render the stored property value; determining a manner upon how to render the stored property value; and rendering the stored property value in accordance with the determined format manner…" In Moran, there is no determination made on how to present information – information is disclosed how it is entered without determining a format manner.

Claim 48 (dependent off claim 13) states "…further comprising disclosing the file preview in accordance with the format manner." Moran does not teach disclosure

with regard to a format manner as recited in claim 48. Disclosure is merely performed with how information is entered and not in accordance with a format manner.

For at least the aforementioned reasons, each and every element is not taught for claims 1 and 13 (and claims dependent therefrom). Therefore the rejection should be removed and placed into a condition for allowance.

IV. Rejection of Claims 51-54 Under 35 U.S.C. §103(a)

Claims 51-54 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dresevic et al. (US 2002/0013795 A1), in view of Lopresti (US 5,734,882). Claims 51-54 has been cancelled which renders the rejection moot; therefore, it is respectfully requested that the rejection be removed.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP2336US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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